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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/178,840 10/26/98 TRIANTAFYLLOU

A P/2432-19

EXAMINER

002352 IM52/1227
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ART UNIT

PAPER NUMBER

1761

DATE MAILED:

12/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/178,840

Applicant(s)

Triantafyllou

Examiner

Curtis E. Sherrer

Group Art Unit

1761



☒ Responsive to communication(s) filed on Oct 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-9, 11-14, 21, and 22 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☒ Claim(s) 1-9, 11-14, 21, and 22 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

☐ Claims _____

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Again, the claims recite using a heat treated malted cereal whereby said malt is treated "to destroy essentially all B-glucanase activity" or to "sufficiently [] inactivate essentially all B-glucanase contained therein." See further discussion below.

4. Claims 1-9, 11-14, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Applicants have amended the claims to recite the phrase "the ingredients employed in the process lacks beta-glucanase activity . . .," and "sufficient to decrease" (should be --sufficient not to decrease--). Also in claim 5 "lack beta-glucanase activity." Also Claim 22, "lack sufficient

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beta-glucanase activity . . . before the process is effected" (only occurs when "mainly the insoluble fibers are removed during the process," page 6).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-9, 11-14, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The Claims 1 and 22 do not provide any positive recitation of process steps.

9. Again, with respect to Claim 2, it is unclear what weight, i.e., pounds, kilograms, etc., and what volume, i.e., gallons, pints, liters, etc., the range is based on. See further discussion below.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 11-14, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindahl (WO95/07628) for reasons set forth in the last Office Action.

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Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papazian (The New Complete Joy of Home Brewing pp. 49, 50, 94 and 95) in view of Lindahl et al. for the reasons set forth in the last Office Action.

Response to Arguments

14. Applicant's arguments filed 09/11/00 have been fully considered but they are not persuasive.

15. Applicant states that the prior art does not have 'a teaching or suggestion of using a milled oat which lacks beta-glucanase activity.' None of the claims recite this limitation, and if it is critical to the invention it should be claimed. Applicant also states that the prior art does not recite a "suspension." Again this is not claimed.

16. In response to the first paragraph rejection, based on lack of enablement, as Applicant has stated for the record, the term "corn" relies on the British definition of the term, i.e, refers broadly to grains.

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17. With reference to the supplied copy of Technology of Cereals, which was not easily readable, no reference was found therein that demonstrated that those of skill in the art know how to produce a cereal or mixtures of cereals so as to "lack beta-glucanase activity." While reference is made to the treatment of lipase enzymes, this is not the same. On page 246, it is stated that the dehydrogenase enzymes are not inactivated, indicating that steaming, as detailed by Technology of Cereals, is not effective to inactivate all enzymes.

Conclusion

18. No claim is allowed.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

20. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Curtis E. Sherrer
Primary Examiner
December 26, 2000